



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

Inventor(s) : Tsang, et al
Filed : 10/11/2000
Serial No. : 09/686,120
Confirmation No. : 4933
Group Art Unit : 2611
Examiner : Saltarelli, Dominic D.
Docket Number : SNY-P3965
Title : IP Address Discovery for Cable Modem in Set Top Box

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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☐ [] transmitted by facsimile to the U.S. Patent and Trademark Office.

Applicant, Assignee or Reg. Representative: Jerry A. Miller, Reg. No. 30779

Signature: B/15/2005 [Signature]

Date: [Signature]

INTERVIEW SUMMARY

Sir:

A telephonic interview was held with Examiner Saltarelli and Primary Examiner Hai Tran on August 10, 2005 with a brief follow up interview held on August 12, 2005. During these interviews, the undersigned presented his position that the Lim reference fails to teach or suggest that which the current Office Action (dated 7/15/2005) alleges is taught. Namely, the Office Action asserts in the paragraph spanning page 3 and 4 that "*(when both a client device*

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and an attached cable modem are initialized, external modems periodically transmit a 'heartbeat' signal over the interconnection which constantly updates the client device regarding the state of the modem, wherein said 'heartbeat' signal includes the most recent IP address assigned to the modem by the DHCP server 110)". The Office Action never cites a passage of Lim or any other reference of record to support this assertion, and the undersigned can find no such teaching. The only relevance of Lim seems to be that Lim shows a cable modem connected to a PC, and discusses a DHCP assigning IP addresses. The reference is silent on how a PC learns the IP address used for communication between the PC and the modem. While Lim discusses use of a DHCP request to obtain an IP address from the DHCP server, there is no discussion whatsoever of the subject matter of Applicant's claims. The Office Action further asserts (second paragraph of item #4) that the *"main circuit board determines IP address of the modem (also an inherent feature...)"*. Applicant has submitted that such is not inherent and even if it were inherent, there is no teaching adequate to meet all of the claim limitations.

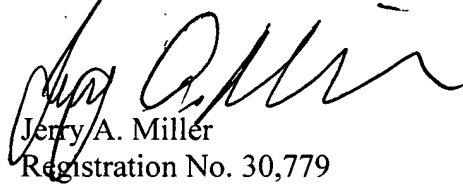
Mr. Tran indicated that all elements of the claim which are not shown in Lim are inherent and can be found at the Microsoft web site. Mr. Tran asserted that the claims read on a device which is rebooted and thus reinitialized to discover an IP address when there is a reassignment of the IP address. This would appear to be in contradiction to the assertion in the present Office Action that there exists some sort of "heartbeat" signal to keep the PC apprised of the IP address. The undersigned was asked to go to the Microsoft web site and find such information. The undersigned protested that it was the Examiner's obligation to present a case of *prima facie* obviousness and that the Examiner should present this evidence if it is relevant and withdraw the rejection; but, Mr. Tran indicated that he would not do so without a formal response to the outstanding Office Action. The undersigned indicated that that was not possible because he was only authorized by the client to conduct an interview, and failing a resolution of patentability at interview, to file an appeal.

(Subsequent to the interview of August 10, the undersigned made a brief attempt to find the information referred to by Mr. Tran without success.)

Despite not having authorization from the client for any amendments, the undersigned suggested several possible amendments. Mr. Tran indicated that such amendments would not

overcome the art and made further reference to art which has never been cited by the Office. Additionally, the undersigned presented evidence that contradicted Mr. Tran's assertion as to how a conventional PC finds out the IP address of a cable modem. Mr. Tran asked that such information be presented in an IDS. The undersigned indicated his intent to do so, and stated that the information was found by the undersigned on August 10, 2005 while preparing for the interview. Such IDS accompanies this interview summary.

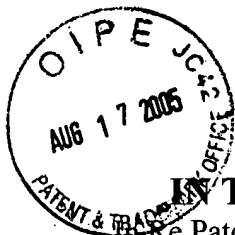
Respectfully submitted,


Jerry A. Miller
Registration No. 30,779

Dated: *8/14/2005*

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Reg. No. 30779

Signature: 

Date: 8/15/05

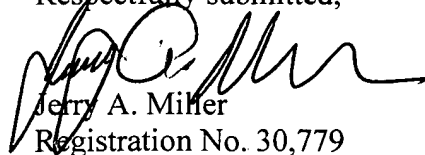
TRANSMITTAL LETTER

Sir:

Enclosed herewith, please find the following:

- Information Disclosure Statement, list of references, copy of reference.
- Fee for IDS by credit card payment form
- Interview Summary
- Notice of Appeal
- Fee for Notice of Appeal by credit card payment form
- Request for Pre-Appeal Brief Request for Review
- Pre-Appeal Brief Remarks
- Receipt post card
- Certificate of Mailing
- The Commissioner is hereby authorized to deduct any underpayment for these submissions from deposit account 501267.

Respectfully submitted,


Jerry A. Miller

Registration No. 30,779

CUSTOMER NUMBER 24337

Dated: 8/15/2005

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